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EXAMINER

CRAIG, DWIN M

ART UNIT

PAPER NUMBER

2123

DATE MAILED: 05/08/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

91

**Office Action Summary**

Application No.

09/518,328

Applicant(s)

BURNS, JOHN J

Examiner

Dwin M Craig

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

Art Unit: 2123

### DETAILED ACTION

1. Claims 1-20 have been presented for examination. Claims 1-20 have been examined and rejected.

#### Drawings

2. Figures 1-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. The Examiner notes that on pages 6-10 of Applicant's specification that figures 1-3 are described as typical and legacy.

#### Specification

3. The attempt to incorporate subject matter into this application by reference of the application (page 1, specification), which appears to consist of essential matter, is improper because there is insufficient identification so as to direct the Examiner or future potential readers to the referenced material. The Examiner requires this information in order to properly review Applicant's specification. Furthermore, if the current application issues as a patent before the application referenced issues, the Applicants will be required to physically incorporate the incorporated material into the instant specification. Please refer to section 608.01(p) which recites:

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found. Guidelines

Art Unit: 2123

for situations where applicant is permitted to fill in a number for Application No. \_\_\_\_\_ left blank in the application as filed can be found in *In re Fouche*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971) (Abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications; both types are open to the public upon the referencing application issuing as a patent. See MPEP § 103).

**Prior to allowance of an application that incorporates essential material by reference to a pending U.S. application, the examiner shall determine if the referenced application has been published or issued as a patent.** If the referenced application has been published or issued as a patent, the examiner shall enter the U.S. Patent Application Publication No. or the U.S. Patent No. of the referenced application in the specification of the referencing application (see MPEP § 1302.04). **If the referenced application has not been published or issued as a patent, applicant will be required to amend the disclosure of the referencing application to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating the amendatory material consists of the same material incorporated by reference in the referencing application.**

## 2. Improper Incorporation

Reliance on a **commonly assigned copending application** by a **different inventor** may ordinarily be made for the purpose of completing the disclosure. See *In re Fried*, 329 F.2d 323, 141 USPQ 27 (CCPA 1964), and *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968). **Since a disclosure must be complete as of the filing date, subsequent publications or subsequently filed applications cannot be relied on to establish a constructive reduction to practice or an enabling disclosure as of the filing date.** *White Consol. Indus., Inc. v. Vega Servo-Control, Inc.*, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983); *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974); *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974)."

The incorporated non-provisional patent application entitled, "A Method of Dispatching Target Instructions Using C Code" listed on page 1 of the specification has not been considered by the Examiner. The Examiner was unable to find the non-provisional patent application and therefore requires that Applicant provide an updated identification number for this non-provisional patent application.

## ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 2123

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 3-5, 8-10, 13, 14, 18-20** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicant's specification fails to disclose in enough detail a method of dispatching target instructions using C code in a manner such that one of ordinary skill in the art could make and/or use the claimed invention without undue experimentation.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 2, 6, 7, 11 and 16** are rejected under 35 U.S.C. 102(b) as being anticipated by **Hoang U.S. Patent 5,925,114**.

5.1 As regards independent **Claims 1 and 11** the *Hoang* reference discloses a data processing system/method (**Figure 1**), having a first processor (**Figure 1 Item 102**), a first software architecture (**Figure 3**), a plurality of emulation objects (**Figure 3, Items 332, 334 and 316**), wherein each of said emulation objects emulates operation of a different one of a plurality of target processors (**Figure 3, Item 332, 334, Col. 3 Lines 50-59, Col. 4 Lines 45-59, Col. 6**

Art Unit: 2123

**Lines 43-56)** has a software architecture different from said first software architecture (**Col. 6 Lines 1-22**).

**5.2** As regards independent **Claims 6 and 16** the *Hoang* reference discloses an apparatus (**Figure 1**).

**5.3** As regards **Claims 2 and 7** the *Hoang* reference discloses and emulation object and a computer program that are compatible with the first software architecture (**Figure 3, Col. 3 Lines 60-67, Co. 4 Lines 1-9**).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 3-5, 8-10, 12-15 and 17-20 are rejected under 35 U.S.C. 103(a) over Hoang U.S. Patent 5,925,114 in view of Orton et al. U.S. Patent 5,379,432 and in further view of Scantlin U.S. Patent 5,574,927.**

**6.1** As regards independent **Claims 1, 2, 6, 7, 11 and 16** see paragraphs 5.1, 5.2 and 5.3 above.

**6.2** As regards **Claim 3, 9, 15, 17 and 18** the *Hoang* reference does not expressly disclose an array of procedures or a list of instructions compatible with a second software architecture.

The *Orton et al.* reference discloses procedure calls (**Figure 2 Item 208**).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the *Hoang* reference with the *Orton et al.* reference because, *(motivation to combine)* the *Orton et al.* reference discloses an object-oriented interface for a procedural operating system (*Orton et al., Col. 1 Lines 20-32*).

The *Scantlin* reference discloses a list of instructions compatible with a second software architecture (**Figure 3, Item 28**).

It would have been obvious to one of ordinary skill in the art, to have modified the *Hoang* reference with the *Scantlin* reference because, *(motivation to combine)* the *Scantlin* reference discloses a method of emulating the instruction execution of one type of processor on another (*Scantlin, Col. 2 Lines 12-49*).

**6.3** As regards **Claims 4, 8, 13, 14, 19 and 20** the *Hoang* reference does not expressly disclose specialized instructions.

The *Scantlin* reference discloses specialized instructions for emulating another processor (**Figure 7, Col. 2 Lines 12-49**).

It would have been obvious to one of ordinary skill in the art, to have modified the *Hoang* reference with the *Scantlin* reference because, *(motivation to combine)* the *Scantlin* reference discloses a method of emulating the instruction execution of one type of processor on another (*Scantlin, Col. 2 Lines 12-49*).

**6.4** As regards **Claim 5** the *Hoang* reference does not expressly disclose an array of procedures corresponds to a list of instructions selected by using an operation code and a corresponding four-bit field.

The *Scanlin* reference discloses a four-bit field operational code field for selecting the correct emulation registers which emulate the target machine instructions (**Figure 7, Col. 9 Lines 12-67**).

It would have been obvious to one of ordinary skill in the art, to have modified the *Hoang* reference with the *Scanlin* reference because, (*motivation to combine*) the *Scanlin* reference discloses a method of emulating the instruction execution of one type of processor on another (*Scanlin, Col. 2 Lines 12-49*).

**6.5** As regards **Claim 10** the *Hoang* reference does not expressly disclose an array of instructions directly linked to a different set of instructions.

The *Scanlin* reference discloses an array of instructions directly linked to a different set of instructions (**Figures 2, 5A, 5B, 7**).

It would have been obvious to one of ordinary skill in the art, to have modified the *Hoang* reference with the *Scanlin* reference because, (*motivation to combine*) the *Scanlin* reference discloses a method of emulating the instruction execution of one type of processor on another (*Scanlin, Col. 2 Lines 12-49*).

**6.6** As regards **Claim 12** the *Hoang* reference does not expressly disclose multiple target processors.

The *Scanlin* reference discloses a plurality of target processors (**Col. 3 Lines 34-36, Col. 4 Lines 34-67, Col. 5 Lines 1-2**).

It would have been obvious to one of ordinary skill in the art, to have modified the *Hoang* reference with the *Scanlin* reference because, (*motivation to combine*) the *Scanlin*



Art Unit: 2123

reference discloses a method of emulating the instruction execution of one type of processor on another (*Scantlin, Col. 2 Lines 12-49*).

**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwain M Craig whose telephone number is 703 305-7150. The examiner can normally be reached on 9:00 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on 703 305-9704. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

DMC  
May 2, 2003

  
HUGH JONES Ph.D.  
PRIMARY PATENT EXAMINER  
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